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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,671	07/02/2003	Jeremiah E. Halley	38190/266715	3462

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EXAMINER

EDMONDSON, LYNNE RENEE

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/612,671

Applicant(s)

HALLEY ET AL.

Examiner

Lynne Edmondson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-9.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Lynne Edmondson
Primary Examiner
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Continuation of 5. does NOT place the application in condition for allowance because: Although the instant preform is made by starting with an oversized part and processing to reach the desired dimensions, the resulting workpiece is the same and would be used in the same manner as a part cut or molded to size. The resulting preform when used as a bridge support has the same structure and performs the same function. There is no indication that an unmachined surface would yield unexpected results..

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Daines et al. (USPN 5035411).

Daines teaches a preform comprising first and second members which have been friction welded, particularly linearly (col 2 lines 22-32). However it is noted that any type of welding process will yield a similar weld joint. The structural members comprise dissimilar metals (Ni and steel, col 1 lines 37-46). See also figures 1, 3 and 4.

3. Claims 1-3, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Jennings (USPN 5697545).

Jennings teaches a preform comprising first and second members which have been friction welded, particularly linearly (col 1 lines 25-52 and col 2 lines 49-56). However it is noted that any type of welding process will yield a similar weld joint. The structural members comprise dissimilar metals (col 3 lines 50-63 and col 7 lines 15-22) including Al or Cu. At least one contact surface is rectangular (col 3 lines 58-63 and figure 10).

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4. Claims 1, 2, 4-6 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (USPN 6219916 B1).

Walker teaches a preform comprising first and second members which have been friction welded, particularly linearly (col 1 lines 25-52 and col 2 lines 49-56) wherein at least one contact surface (48) comprises a rectangular block (figure 2) . However it is noted that any type of welding process will yield a similar weld joint. The structural members comprise Ti alloys (col 7 lines 56-65).

5. Claims 1, 2, 4-6, 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Norris et al. (USPN 6669447 B2).

Norris teaches a preform comprising first and second members which have been friction welded, particularly linearly (col 4 lines 52-64) wherein at least one contact surface (40, 72) comprises a rectangular block (figure 3) . However it is noted that any type of welding process will yield a similar weld joint. The structural members comprise Ti alloys (col 2 lines 55,56).

6. Claims 1-3, 5 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Foster et al. (US 2002/0036225 A1).

Foster teaches a preform comprising first and second members which have been friction welded, particularly linearly (paragraphs 18-20). However it is noted that any type of welding process will yield a similar weld joint. The structural members comprise dissimilar materials, one of which is a Ti alloy (paragraphs 5 and 27).

Response to Arguments

7. In response to applicant's argument that the references teach a machined outer surface rather than an unmachined outer surface to be used as an intermediary member, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Although the claimed preform is made by starting with an oversized part and processing to reach the desired dimensions, the resulting workpiece is the same and would be used in the same manner as a part cut or molded to size. The resulting preform when used as a bridge support has the same structure and performs the same function. There is no indication that an unmachined surface would yield unexpected results.

8. Therefore the 102 rejection of claims 1-3 as anticipated by Daines stands.
9. The 102 rejection of claims 1-3, 8 and 9 as anticipated by Jennings stands.
10. The 102 rejection of claims 1, 2, 4-6 and 8 as anticipated by Walker stands.
11. The 102 rejection of claims 1, 2, 4-6, 8 and 9 as anticipated by Norris stands.
12. The 102 rejection of claims 1-3, 5 and 7 as anticipated by Foster stands.

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Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynne Edmondson whose telephone number is (571) 272-1172. The examiner can normally be reached on Monday through Thursday from 6:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lynne Edmondson
Primary Examiner
Art Unit 1725

LRE

LYNNE R. EDMONDSON
PRIMARY EXAMINER

LRE
1/14/05